

REMARKS

Amendments to the Claims:

Claim 22 has been amended to correct a typographical error. Specifically, the word "further" has been deleted from the claim. The Applicant had intended to delete the word "further" from claim 22 as part of an earlier-filed amendment.

Each of claims 19 and 27 has been amended to change the phrase "wherein the client does not specify an arrangement of components to create the document" to the phrase, "wherein the algorithm automatically specifies an arrangement of components to create the document."

These amendments are supported by the specification as follows:

The selected literature is automatically assembled from a database and printed to form a booklet. (Applicant's specification, page 6, lines 6-7.) It is to be understood that each of the steps discussed herein which are described as being performed by the apparatus 100 can be accomplished automatically. When I say "automatically" I mean that a step can be performed without human action. That is, each of the steps which are described herein as being carried out by the apparatus 100, any component thereof, can be performed entirely by the apparatus, including the respective components thereof, without any human action or intervention. (Id., page 22, lines 11-16.) An apparatus in accordance with the present invention is configured to automatically produce a booklet containing literature which is selected by the client.... (Id., page 6, lines 26-27.) The apparatus 100 can also comprise a literature assembly algorithm 205. The literature assembly algorithm 205 can be employed cause the processor 215, using the other components of the controller 110, to assemble the portions of the literature which are requested by the client "C." (Id., page 10, lines 6-9.) The literature assembly algorithm 205 can comprise a series of computer executable steps (a "program") which can be stored in the memory 201 and executed by the processor 215. That is, the literature assembly algorithm 205 is preferably configured to cause the processor 215 to access the database 203 and to retrieve therefrom the specific literature which is requested by the client "C." After accessing the database 203, and retrieving the requested literature therefrom, the literature assembly algorithm 205 causes the processor 215 to organize the requested technical literature together in a logical sequence and order, and formats the technical literature for printing in the booklet "B" to be

1 *produced by the booklet-producing device 130. (Id., page 10, lines 11-19.) The*
2 *finish command signal can be received by the signal receiver algorithm 213 which*
3 *can, in turn, initiate the retrieval of the literature selections of the client "C" from the*
4 *memory 201. In accordance with step S220, the appropriate literature is then*
5 *retrieved from the database 203 by the processor 215, whereupon the literature*
6 *selections are transmitted to the booklet-producing device 130, assembled and*
7 *placed into printing format by the literature assembly algorithm 205.... (Id., page 19,*
8 *lines 13-19.)*

8 Rejection of the Claims Under 35 U.S.C. 112:

9 Claims 19-34 have been rejected under U.S.C. 112, first paragraph, as failing
10 to comply with the enablement requirement. The Examiner contends that the claims
11 contain subject matter which was not described in the specification in such a way as
12 to enable one skilled in the art to which it pertains, or with which it is most nearly
13 connected, to make and/or use the invention.

14 Specifically, the Examiner contends that claims 19 and 27 were amended to
15 recite "wherein the client does not specify an arrangement of components to create
16 the document," and that this phrase somehow causes the claims to fail to comply
17 with the enablement requirement.

18 The Applicant has amended the claims so that the phrase "wherein the client
19 does not specify an arrangement of components to create the document," no longer
20 appears in the claims.

21 The Applicant contends that the rejections of claims 19-34 under 35 U.S.C.
22 112 is therefore overcome, and the Applicant requests that those rejections
23 be withdrawn.

24 Rejection of Claims Under 35 U.S.C. §103:

25 Claims 19-34 have been rejected under 35 U.S.C. §103(a) as being
unpatentable over U.S. Patent 6,134,568 to Tonkin ("Tonkin") in view of EP 0621563
A1 to Tonkin ("EP").

The Applicant notes that a rejection under 35 U.S.C. §103 requires that the
prior art references when combined must teach or suggest all the claim limitations.
(MPEP 706.02(j).)

1 As is noted above, the Applicant has amended claims 19 and 27 so that each
2 of those claims now includes the following element:

3 providing ... a literature assembly algorithm ... wherein the algorithm
4 automatically specifies an arrangement of components to create the document.

5 The Applicant contends that neither Tonkin nor EP teaches or suggests this
6 new element contained in each of claims 19 and 27, as amended. The Examiner
7 relies on EP only for teaching a postage marking calculated based on a total weight
8 of a booklet. The Applicant agrees that EP does not disclose any other relevant
9 teachings. That is, EP does not teach providing ... a literature assembly algorithm
10 ... wherein the algorithm automatically specifies an arrangement of components to
create the document as is now required by each of claims 19 and 27.

11 Tonkin not only does not disclose this new element of claims 19 and 27, but
12 also teaches away it. Specifically, Tonkin teaches that the user inputs information
13 specifying an arrangement of components to create the document. (Tonkin,
14 abstract, col. 2, lines 27-33, 41-50, col. 6, lines 22-40, also see figures 4-9.) By
15 contrast, the Applicant's claims require that the user does not provide any input in
16 regard to specifying an arrangement of the components to create the document.
17 That is, in accordance with the Applicant's claims, the arrangement of the
18 components to create the document is performed automatically by the literature
19 assembly algorithm with no input from the user.

20 Thus, because Tonkin teaches that the user inputs information specifying an
21 arrangement of components to create the document, it follows that Tonkin teaches
22 away from the Applicant's claims which require providing ... a literature assembly
23 algorithm ... wherein the algorithm automatically specifies an arrangement of
24 components to create the document.

25 Therefore, neither of claims 19 or 27 is obvious in view of Tonkin and/or EP
because Tonkin and/or EP, either individually or when combined, do not teach or
suggest all of the limitations of either claim 19 or claim 27, as is required for a finding
of obviousness.

Accordingly, the Applicant respectfully requests that the rejections of claim 19
and claim 27 be withdrawn and that each of those claims be allowed.

1 The Applicant notes that each of claims 20-26 depends from claim 19. Thus,
2 each of claims 20-26 contains all of the elements of claim 19. Therefore, each of
3 claims 20-26 is nonobvious in view of Tonkin and/or EP for at least the reasons that
4 claim 19 is nonobvious as set forth herein above.

5 Similarly, the Applicant notes that each of claims 28-34 depends from claim
6 27, and that each of claims 28-34 thus contains all of the elements of claim 27.
7 Therefore, each of claims 28-34 is nonobvious in view of Tonkin and/or EP for at
8 least the reasons that claim 27 is nonobvious as set forth herein above.

9 Accordingly, the Applicant respectfully requests that the rejections of each of
10 claims 20-26 and 28-34 be withdrawn and that each of those claims be allowed.

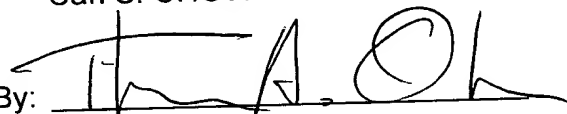
11 SUMMARY

12 The applicant believes that this communication is fully responsive to the Office
13 action mailed 11/29/2006. The Applicant requests timely allowance of claims 19-34.

14 Respectfully submitted,

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Date: January 29, 2007